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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : M. ARONHIME et al.

Group Art Unit : 1774

Appl. No : 09/011,634

Examiner : Grendzynski

Filed : August 16, 1996 as International Application No. PCT/NL96/00323

For : INTERMEDIATE TRANSFER BLANKET AND METHOD  
OF PRODUCING THE SAME

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**ELECTION WITH TRAVERSE**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

This is in response to the requirement for restriction under 35 U.S.C. 121 and 372 mailed from the U.S. Patent and Trademark Office on February 28, 2000, which sets a one month shortened statutory period for response until March 28, 2000.

Applicants hereby request an extension of time for one month to extend the period for response until April 28, 2000, and are concurrently filing a formal Request for Extension of Time for one month accompanied by the government extension of time fee for one month. If for any reason the formal Request for Extension of Time is not associated with the file and/or the fee is deficient, this is an express request for any required extension of time, and authorization for the Commissioner to charge any necessary fee, including any required extension of time fee, to Deposit Account No. 19-0089.

Reconsideration and withdrawal of the requirement for restriction are respectfully requested in view of the remarks which follow:



DISCUSSION OF RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. 121 and 372:

- I. Claims 1-28 and 60 drawn to a method of producing a multi-layered image transfer member.
- II. Claims 29-45 drawn to an image transfer member comprising silicone release layer.
- III. Claims 46 and 47, drawn to an apparatus for producing a multi-layered image.
- IV. Claims 48-57, drawn to an image transfer receiving sheet.
- V. Claims 58 and 59, drawn to an image transfer blanket.
- VI. Claims 61-64, drawn to an intermediate transfer sheet comprising a drum.
- VII. Claim 65, drawn to a carrier layer.

The Examiner contends that the inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. In the instant situation, the Examiner contends that the special technical feature of the present invention - an image transfer member suitable for the transfer of toner images and having an outer release layer of silicon [ sic ] - does not define a contribution over the prior art, referring to Clemens, column 3, lines 23-28, whereby a lack of unity of invention is asserted to exist.

ELECTION

In order to be responsive to the requirement for restriction, Applicants elect the invention set forth in Group II, claims 29-45, with traverse.

For the reasons set forth below, Applicants submit that the restriction requirement is improper, and should be withdrawn, whereby an action on the merits of all of the pending claims is warranted.

TRAVERSE

Notwithstanding the election of the claims of Group II in order to be responsive to the requirement for restriction, Applicants respectfully traverse the requirement.

Applicants note that 37 C.F.R. 1.475 provides:

Unity of invention before the International Searching Authority, the International Preliminary Examining Authority, and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product;  
or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and w 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Applicants point out that in determining unity of invention the criteria set forth in 37 C.F.R. 1.475 must be considered. Thus, in stating the restriction requirement, the requirement must state why unity of invention is lacking at least under 1.475(a) and (b). Therefore, the restriction requirement is improper for not discussing the various sections of 1.475.

Still further, while unity of invention was found to be lacking during International prosecution, upon payment of the additional fees, a search of all of the pending claims was performed by the International Searching Authority. Accordingly, there should be no undue burden to examine all of the pending claims, because, as previously noted, the International Searching Authority has already performed a search of each of the pending claims.


In view of the foregoing, it is respectfully requested that the Examiner seriously reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.

Allowance of the application is requested, with an early mailing of the Notices of Allowance and Allowability.

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If the Examiner has any questions or wish to further discuss this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,  
M. ARONHIME et al.



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April 28, 2000  
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